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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,151	01/08/2001	James S. Boyce	10003916-1	6995

7590

07/29/2004

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

MENBERU, BENIYAM

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 07/29/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/757,151

Applicant(s)

BOYCE, JAMES S.

Examiner

Beniyam Menberu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The use of the trademark NETSCAPE NAVIGATOR has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The disclosure is objected to because of the following informalities: The reference number 56 in the specification (page 5, line 2) should be enclosed by parenthesis.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 4,10, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose specifically how to analyze the file to

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determine irresolvable elements (page 4, lines 29-30) and it also fails to disclose the method used to resolve this irresolvable elements (page 5, lines 1-2).

5. Claims 3, 9, and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to disclose specifically how to determine the file type when analyzing the contents of the file (page 4, lines 10-11).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,2,6,7,8,12,13,14, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5559933 to Boswell.

Regarding claims 1 and 7 Boswell discloses an apparatus for implementing the method of receiving file name and path, determining file type, and printing file types which are ready to print. Boswell's system has input for receiving print files (Figure 7, reference 272) where the print files can be identified by path (column 18, lines 20-25) and file name (column 14, lines 4-5). Boswell discloses a mask to identify file types (column 13, lines 65-57; column 14, lines 1-5) and requesting of a print job when a

matching mask is found (column 17, lines 48-55). Files from Personal Computers (PC) can be printed when the PC is connected to a file server (column 22, lines 7-13) and it has a print job.

Regarding claims 13 Boswell discloses computer program to implement the method of receiving file name and path, determining file type, and printing file types which are ready to print (column 31, lines 37-58).

Regarding claim 2 and 8 Boswell discloses a mask to implement the method of identifying file types from a list of masks (Figure 11, reference 370; column 19, lines 42-47) using the file type attribute selection in Figure 11. The matching mask can result in a request for a print job (column 17, lines 48-55).

Regarding claims 14 Boswell discloses computer program to implement the method of receiving file name and path, determining file type, and printing file types which are ready to print (column 31, lines 37-58).

Regarding claims 6, 12, and 18 Boswell discloses an apparatus and program to implement the method of opening user interface for printing options (column 4, lines 60-64; column 27, lines 37-42)

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 3,9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5559933 to Boswell in view of U.S. Patent No. 6650431 to Roberts et al.

Regarding claims 3,9, and 15 Boswell discloses an apparatus and a computer program to implement the method of receiving file name and path, determining file type using a mask, and printing file types which are ready to print (column 31, lines 37-58).

Boswell does not disclose a method of determining file type by analyzing the contents of a file.

Roberts et al discloses an apparatus (Figure 2, references 204,206,208; column 8, lines 14-34) and a computer program (column 24, lines 36-67) for implementing the method of analyzing contents of files to determine the types of files before printing.

Boswell and Roberts et al are combinable because they are from the similar problem solving area of printing different file types.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement the parser of Roberts et al in the system of Boswell to determine the file type of the print file.

The motivation to combine the reference is clear because in the situation that the file extension of a file were unknown, the best option is to determine the file type by analyzing the contents of the file using the method of Roberts et al in the system of Boswell so as to print the file in the right way.

10. Claims 4,5,10,11,16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5559933 to Boswell in view of U.S. Patent No. 5963641 to Crandall et al.

Regarding claims 4,5,10,11,16 and 17 Boswell discloses an apparatus and a computer program to implement the method of receiving file name and path, determining file type using a mask, and printing file types which are ready to print (column 31, lines 37-58).

Boswell does not disclose an apparatus and computer program to implement the method of analyzing contents of print files for irresolvable elements such as fonts, images, and patterns.

Crandall et al discloses an apparatus and computer program to implement the method of analyzing contents of print files for irresolvable elements such as fonts, images, and patterns and correcting them (column 1, lines 50-52; column 1, lines 28-35; column 2, lines 2-4).

Boswell and Crandall et al are combinable because they are from the similar problem solving area of processing print files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement the system of Crandall et al in Boswell's system before printing to correct any incompatibilities that occur in print files.

The motivation to combine the reference is clear because Crandall et al mentions the need to examine print files before printing is necessary because of the complexity of print document files (column 1, lines 65-57; column 2, lines 1-22).

***Other Prior Art Cited***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5483653 to Furman discloses a printing system that uses parsing on print specifications.

U.S. Patent No. 6362894 to Shima discloses a system for printing information from Internet sources.

U.S. Patent No. 6633400 to Sasaki et al discloses a client/server apparatus for printing systems.

U.S. Patent Application Publication No. US 2003/0115551 A1 to Deleeuw discloses a method for analyzing files for text data.

U.S. Patent No. 5825991 to Plakosh et al discloses a printing system with decomposing capability.

U.S. Patent No. 5778359 to Stent discloses a method for determining the format of files.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (703) 306-3441. The examiner can normally be reached on 8:00AM-4:30PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (703) 306-5631. The group receptionist number for TC 2600 is (703) 305-4700.

***Patent Examiner***

Beniyam Menberu

07/15/2004

  
**KIMBERLY WILLIAMS**  
**SUPERVISORY PATENT EXAMINER**